

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/240,250 Confirmation No. 7144

Applicant : Brian Paul BOESCH

Filed : January 29, 1999

Title : E-MAIL INVOKED ELECTRONIC COMMERCE

TC/A.U. : 3661

Examiner : Cuong H. NGUYEN

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The above-identified application having been finally rejected in the Office Action mailed October 29, 2007, Applicant respectfully submits this Pre-Appeal Brief Request for Review within two months of the mailing date of the Office Action (December 29 having fallen on a Saturday, and December 30 having fallen on a Sunday).

Applicant requests the review for the reason(s) stated on the attached sheets. No amendments are being filed with this request.

A Notice of Appeal is being submitted concurrently herewith.

REMARKS/ARGUMENTS

Claims 80-83, 85, 87, and 89-96 are pending. In the Office Action, Examiner rejected claims 80-83, 85, 87, 89-92, and 94-96 under 35 U.S.C. §103(a) as unpatentable over Stein (USP 6,246,996) in view of Kuzma (USP 5,771,335) and further in view of Perkowski (US Pub 2002/0004753). The Examiner also rejected claims 87, 89, 90, and 93 under 35 U.S.C. §103(a) as unpatentable over Stein in view of Kuzma, and further in view of Wiser (USP 6,385,596). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the claims in view of the following arguments.

One of the fundamental factual flaws (which also becomes a legal flaw) in the Examiner's position is that, in the last two Office Actions, the Examiner has not addressed the actual language of the claims. Consequently, the Examiner has not addressed the approximately seven pages of Applicant's arguments regarding that claim language. For example, on page 5 of the last two Office Actions, the Examiner purports to quote claim 80, even though claim 80 was amended in the January 29, 2007 response, in at least two ways:

- 1) Applicant removed reference to an electronic mail message (in the last two Office Actions, when addressing claim 80, the Examiner has continued to refer to electronic mail messages).
- 2) The recited storing in claim 80 (and also in claim 93, which Applicant added in the January 29, 2007 response) specifies that the consumer does not have to register separately with individual merchants. In the last two Office Actions, the Examiner has failed to address this last limitation.

Additionally, claim 93 recites not only, at a merchant computer, sending a first electronic mail message having a link including an Internet address of a consumer information server, but also, at a consumer information server, sending a second electronic mail message indicating that registration information (recited earlier in the claim as including consumer identification information, a consumer electronic mail address, and a consumer passphrase) was stored. In the last two Office Actions, the Examiner has not addressed this limitation, either.

Yet another factual and legal flaw in the Examiner's analysis is that the Examiner has treated all of the recited hardware as general-purpose hardware. However, the specific functions

which the claims recite make that hardware specifically-programmed hardware, which therefore is substantially different from general purpose hardware. The Court of Appeals for the Federal Circuit has indicated that a programmed computer becomes a different machine. *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994).

The Examiner's generic approach has led to still another factual and legal flaw, which is the piecemeal treatment of claimed elements, rather than a consideration of the claimed invention as a whole, including the reliance of claimed elements on each other.

Because this pre-appeal request for review is page-limited, Applicant cannot set forth all of the arguments that have been made. However, Applicant sets forth some of those arguments here, and respectfully refers the Panel to the January 29, 2007 and August 7, 2007 responses for more detail.

The claims recite the carrying out of electronic transactions over a network, where at least a merchant computer and a consumer information server are involved. The transactions clearly are commercial transactions. The claimed invention is therefore concerned with availability of registration information on the consumer information server. The invention enables subsequent commercial transactions without the consumer having to separately register purchase information with each individual merchant.

Looking at the prior art, the Stein reference teaches payment, from one entity to another, over a network. The Kuzma reference teaches transmission of electronic mail, and has nothing to do with a consumer transaction. Perkowski relates to a database of product information based on UPC information, and has nothing to do with storing consumer information to enable subsequent consumer transactions so that the consumer does not have to register separately with respective merchants.

Instead of looking at the actual claim language, the Examiner generalized the invention of claim 80 as "about getting related information before doing an electronic transaction". This description does not consider all the elements of the claim, including the consumer registration process and the storage of consumer information for future use with a plurality of different merchants. The Examiner has treated independent claim 93 similarly.

The Examiner indicated that the method of claim 80 has been suggested by Stein and Perkowski. Importantly, the information that Perkowski stores is not consumer information. It has nothing to do with any particular consumer's information. Rather, Perkowski stores consumer product information. This storage does not prevent a consumer from having to register consumer information separately with each merchant with whom the customer desires to do business.

In paragraph 5A of the Office Action, the Examiner argued that Stein "teaches a structure for all transaction communication between a seller and an Internet server." Applicant submits that this interpretation of Stein is overbroad. Stein, at best, teaches communication between two users, where one user is to pay another user. There is nothing in this reference that suggests storage of registration information at a consumer information server, so that a consumer can use that information to conduct transactions with a plurality of merchants, without having to register with each merchant. The Stein reference is further limited to the sale of an information product deliverable over the Internet and an exchange approved via email communication, with the actual monetary transaction concluded off-line between two account holders on the described payment system. There is no mention of one of these entities being able to conduct transactions with multiple entities without having to re-register with each entity.

While the Examiner has reiterated that Kuzma and Stein talk about a "middle man" which might be a server or the Internet, the claims recite a consumer information server with more specific attributes. "The Internet" does not store information. The Examiner's reference to a "server" is far too generic. Servers store information, but Stein and Kuzma do not teach or suggest the combination of registration information storage and merchant computer information that the claims of the present application recite.

Even assuming *arguendo* that Stein, Kuzma, and Perkowski show everything that the Examiner says, other claim elements still are missing. Particularly, nothing in the Examiner's rejection adequately addresses the element of "storing the registration information for use in subsequent consumer transactions so that the consumer does not have to register separately with respective merchants." The Examiner asserts that "buyer's computer often stores or prints out registration information page as evident of an electronic transaction that could be used later."

However, this has nothing to do with the storage of registration information by a consumer information server, and the Examiner does not even so allege. Moreover, the Examiner has failed to support the argument with any evidence of specific prior art. For this reason as well, the Examiner has failed to point to specific teachings that clearly suggest every claim limitation.

Additionally, the Examiner has not presented any reason why one skilled in the art would have combined Stein, Kuzma, and Perkowski in order to piece together the invention as claimed. The Supreme Court, in *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, 14 (2007), indicated that an analysis should indicate “there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” Without more, the argument appears to be composed of mere conclusory statements reliant on hindsight bias. Therefore, Applicant submits that the Examiner has failed to present a *prima facie* case of obviousness.

CONCLUSION

The foregoing discussion highlights some of the flaws in the Examiner’s analysis, relating primarily to claim 80 and its dependencies. Claim 93 and its dependencies are yet more specific, and even more clearly distinguishable from the prior art on which the Examiner has relied. Accordingly, Applicant respectfully requests that the Examiner’s rejections be withdrawn. Applicant believes the claims are in condition for allowance. The Commissioner is authorized to charge any fees or credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Respectfully submitted,
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